

Serial No.: 10/625,171
Amdt. Dated: September 29, 2006
Reply to Office action of June 29, 2006

130502-1

REMARKS

In the Office Action of June 29, 2006, claims 1-16, 28-30 were rejected. The Examiner had previously withdrawn claims 17-27. In this response, claim 1 has been amended, claims 11-16, and 28-30 have been cancelled, and new claims 31 and 32 have been added. In light of these amendments, the Applicants request reconsideration and allowance of claims 1-10 and newly added claims 31-32.

The Applicants affirm the provisional election of the Group I claims, Claims 1-16, and 28-30 made by Applicants' representative Andrew J. Caruso on March 28, 2006, during a telephone conversation with the Examiner.

In the present Office Action, the Examiner rejected Claims 6, 13, and 14 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter; claims 1-3, 7-11, 13, 15, and 16 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 4,104,099 (Scherrer); claims 1, 2, 7, 11, 13, and 28-30 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 6,142,044 (Freund); claims 1, 7, and 9-11 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 4,644,639 (Atteberry); claims 1, 7-11, and 14-16 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,633,541 (Andrews); claims 1-3, 5-7, and 11-14 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,217,222 (Rudell); claims 4, 5, and 6 were rejected under 35 USC 103(a) as being unpatentable over Scherrer; claims 12 and 14 were rejected under 35 USC 103(a) as being unpatentable over Scherrer in view of U.S. Patent No. 5,718,618 (Gukel); and finally claim 4 was rejected under 35 USC 103(a) as being unpatentable over Rudell. The Applicants urge that especially as amended claims 1-10 and 31-32 recite patentable subject matter, which is neither disclosed nor suggested by any of the cited references either singly or in combination.

Claim Amendments

In this response, claim 1 has been amended. Claim 1 has been amended to recite a polymer film comprising an ultra-high barrier coating. Antecedent basis for the

7 / 7

Serial No.: 10/625,171
Amdt. Dated: September 29, 2006
Reply to Office action of June 29, 2006

130502-1

limitation that the polymer film comprise an ultra-high barrier coating may be found in paragraph 38 of the instant application.

35 U.S.C. § 112 Rejections

In the Office Action of June 29, 2006, the Examiner rejected Claims 6, 13, and 14 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Original claim 6 was held to be indefinite because it lacked antecedent basis for the phrase "said polymer film". Similar deficiencies in antecedent basis were cited in rejecting claims 13 and 14. In this response, claim 1 has been amended to recite a "polymer film" and claims 13 and 14 have been cancelled, thus making the rejection of claims 13 and 14 moot. The Applicants therefore respectfully request that the rejection of claim 6 under 35 USC 112, second paragraph, be withdrawn.

35 U.S.C. § 102 (b) Rejections

In the Office Action of June 29, 2006 originally filed claims 1-3, 7-11, 13, 15, and 16 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 4,104,099 (Scherrer). Originally filed claims 1, 2, 7, 11, 13, and 28-30 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 6,142,044 (Freund). Originally filed claims 1, 7, and 9-11 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 4,644,639 (Atteberry). Originally filed claims 1, 7-11, and 14-16 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,633,541 (Andrews). Originally filed claims 1-3, 5-7, and 11-14 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,217,222 (Rudell). The rejection of claims 1-10 is respectfully traversed. Especially as amended, the claims recite patentable subject matter over the cited references which do not disclose each and every element of the invention as current claimed.

Applicant's broadest claim, currently amended claim 1, recites an apparatus comprising:

Serial No.: 10/625,171
Amdt. Dated: September 29, 2006
Reply to Office action of June 29, 2006

130502-1

a polymer film comprising an ultra-high barrier coating; and
a fixture comprising at least one inner member and at least one outer member,
wherein said at least one inner member and said at least one outer member are configured
to secure said film therebetween.

The Scherrer reference discloses an article comprising a polymer film. Scherrer does not, however, disclose or suggest a polymer film comprising an ultra-high barrier coating as recited by amended claim 1. Because Scherrer does not disclose each and every limitation of the Applicants' claimed invention, the rejection of claims 1-3, 7-10 may not properly be made under 35 USC 102(b). Claims 11-16 are cancelled. Thus, the Applicants courteously request that the rejection of claims 1-3, and 7-10 under 35 USC 102(b) as anticipated by Scherrer be withdrawn.

Freund discloses an article comprising a thermoplastic film. Freund does not, however, disclose or suggest a polymer film comprising an ultra-high barrier coating as recited by amended claim 1. Because Freund does not disclose each and every limitation of the Applicants' claimed invention, the rejection of amended claim 1, and its dependent claims may not properly be made under 35 USC 102(b). Claims 11,13, 28-30 have been cancelled. Thus, the Applicants courteously request that the rejection of claims 1-2, and 7 under 35 USC 102(b) as anticipated by Freund be withdrawn.

Attebery discloses an article comprising a commercially available polymer film. Attebery does not, however, disclose or suggest a polymer film comprising an ultra-high barrier coating as recited by amended claim 1. Because Attebery does not disclose each and every limitation of the Applicants' claimed invention, the rejection of amended claim 1, and its dependent claims may not properly be made under 35 USC 102(b). Thus, the Applicants courteously request that the rejection of claims 1,7 and 9-10 under 35 USC 102(b) as anticipated by Attebery be withdrawn.

Andrews discloses an assembly for supporting cloth, or other sheet material, upon which markings, such as paintings or drawings, are made by felt tipped, ball point or other marking devices. Andrews does not disclose or suggest a polymer film comprising

Serial No.: 10/625,171
Amdt. Dated: September 29, 2006
Reply to Office action of June 29, 2006

130502-1

an ultra-high barrier coating as recited by amended claim 1. Because Andrews does not disclose each and every limitation of the Applicants' claimed invention, the rejection of amended claim 1, and its dependent claims may not properly be made under 35 USC 102(b). Claims 11-14 are cancelled. Thus, the Applicants courteously request that the rejection of claims 1 and 7-10 under 35 USC 102(b) as anticipated by Andrews be withdrawn.

Ruddel discloses an article comprising a plastic film. Ruddel does not disclose or suggest a polymer film comprising an ultra-high barrier coating as recited by amended claim 1. Because Ruddel does not disclose each and every limitation of the Applicants' claimed invention, the rejection of amended claim 1, and its dependent claims may not properly be made under 35 USC 102(b). Claims 11-14 are cancelled. Thus, the Applicants courteously request that the rejection of claims 1-3, and 5-7 under 35 USC 102(b) as anticipated by Ruddel be withdrawn.

35 U.S.C. § 103 (a) Rejections

Claims 4, 5, and 6 were rejected under 35 USC 103(a) as being unpatentable over Scherrer; claims 12 and 14 were rejected under 35 USC 103(a) as being unpatentable over Scherrer in view of U.S. Patent No. 5,718,618 (Gukel); and claim 4 was rejected under 35 USC 103(a) as being unpatentable over Rudell. The rejection of claims 4, 5, and 6 is respectfully traversed. Claims 12 and 14 have been cancelled.

As a threshold requirement for rejection under 35 USC 103(a), the Examiner must first satisfy the requirements needed to establish a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based

Serial No.: 10/625,171
Amdt. Dated: September 29, 2006
Reply to Office action of June 29, 2006

130502-1

on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).
See MPEP Section 2143 - Section 2143.03

The Applicants urge that a prima facie case of obviousness has not been established. With respect to the first requirement: that there be some suggestion or motivation, either in the reference or knowledge generally available to one of ordinary skill in the art, to modify the reference to arrive at the claimed invention; the Applicants note that there is no suggestion or motivation in any of the cited references to modify or combine the cited references to arrive at the current invention, an apparatus comprising a polymer film wherein the polymer film comprises an ultra-high barrier coating, and wherein the film is disposed in a particular manner between an inner member and an outer member configured in such a manner so as to secure the film.

As discussed above, Scherrer discloses polymer films. Scherrer does not, however, suggest a polymer film comprising an ultra-high barrier coating within the context of an apparatus of the claimed invention as recited by amended claim 1. Thus, the Scherrer reference cannot be used as the basis for prima facie obviousness because the Scherrer reference fails to disclose or suggest all of the elements of the claimed invention. Because the threshold requirement for an obviousness rejection under 35 USC 103(a) has not been met, a rejection under this section is unwarranted. Thus, in light of the amendment to claim 1 the Applicants urge that claims 4, 5 and 6 recite patentable subject matter over Scherrer. Therefore, the Applicants respectfully request that the rejection of claims 4, 5, and 6 under 35 U.S.C.103 (a) as being unpatentable over Scherrer be withdrawn.

Claims 12 and 14 are cancelled and hence the rejection is moot.

The rejection of claim 4 under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,217,222 (Rudell) is respectfully traversed. Rudell discloses a racket having a perimeter frame with a tympanum stretched across the frame and formed of a flexible film tautly stretched within the frame, thereby forming a sound-reverberating and resonating ball impact surface, and a handle which extends outwardly from the frame. While Rudell discloses various types of polymer films which may be stretched upon the frame to create the racket's ball impact surface there is no suggestion that the polymer

Serial No.: 10/625,171
Amdt. Dated: September 29, 2006
Reply to Office action of June 29, 2006

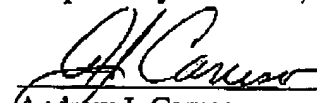
130502-1

film comprise an ultra-high barrier coating. Moreover, Rudell is directed toward a plastic toy product. As the instant application makes clear, the present invention is directed to an apparatus useful in the preparation of electronic devices such as OLEDs. As such, Rudell represents entirely non-analogous art. Because Rudell neither discloses nor suggests the limitations of claim 4, the Applicants respectfully request that the rejection of claim 4 under 35 USC 103(a) as being unpatentable over Rudell be withdrawn.

In view of the foregoing arguments, the Applicants believe that each of claims 1-10, and new claims 31-32 is now in condition for allowance. The Applicants thus courteously solicit prompt notice of allowance for these claims.

Should the Examiner believe that anything further is needed to place the application in even better condition for allowance, the Examiner is requested to contact the Applicants' undersigned representative at the telephone number below.

Respectfully submitted,


Andrew J. Caruso
Reg. No. 48,520

GE Global Research
One Research Circle
Building K1, Room 3A71
Niskayuna, New York 12309
September 29, 2006
Telephone: (518) 387-7354